

Christophe P.G. Gerald, et al.
Serial No.: 09/866,248
Filed: May 25, 2001
Page 10

REMARKS

Claims 183-191 are pending in the subject application. By this amendment, applicants have amended claims 184 and 191. Accordingly, upon entry of this Amendment, claims 183-191, as amended, will be pending and under examination.

Applicants maintain that the amendments to the claims raise no issue of new matter and respectfully request entry of this Amendment.

Rejection Under 35 USC § 112, First Paragraph

On page 2 of the December 23, 2004 Office Action, the Examiner rejected claims 183-191 under 35 USC 112, first paragraph for allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner alleged that if the deposit was made under the provisions of the Budapest Treaty, then the filing of an affidavit or declaration by applicants, assignees or a statement by an attorney of record over his or her signature and registration number stating that the deposit had been accepted by an International Depository Authority under the provisions of the Budapest Treaty, that all restrictions upon access to the deposits will be irrevocably removed upon the grant of a patent on the application and that if the deposit will be replaced if viable samples cannot be dispensed by the depository is required.

In response, applicants' undersigned attorney states herewith that in accordance with 37 C.F.R. §1.808(a)(2) all restrictions imposed by the depositor on the availability to the public of the deposited materials will be irrevocably removed upon the granting of a patent from the subject application. Applicants transmit herewith a copy of the ATCC Deposit Receipt for plasmid pCDNA3.1-hNPFF2b (ATCC Accession No. 203255) indicating that the deposit

Christophe P.G. Gerald, et al.
Serial No.: 09/866,248
Filed: May 25, 2001
Page 11

was made under the terms of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purpose of Patent Procedure on September 22, 1998.

Applicants also note that the date of the deposit, the complete name and address of the depository, and the accession number of the deposited plasmid can be found in the specification as originally filed on page 40, lines 14-21.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Rejection Under 35 USC § 112, Second Paragraph

On page 4 of the December 23, 2004 Office Action, the Examiner rejected claim 184 under 35 USC 112, second paragraph for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter the application regards as the invention. The Examiner specifically alleged that claim 184 is indefinite because while it is directed to a method of finding an agonist, the method steps recite that the compound identified will decrease the mammalian NPFF receptor activity.

In response, in an attempt to advance the prosecution but without conceding either the need for amendment or the correctness of the Examiner's position, Applicants have amended claim 184 to recite a process for preparing a composition, which comprises determining whether a compound is a mammalian NPFF receptor antagonist.

Accordingly, Applicants maintain that the amendment to claim 184 obviates this rejection and respectfully request that the rejection be withdrawn.

Christophe P.G. Gerald, et al.
Serial No.: 09/866,248
Filed: May 25, 2001
Page 12

Information Disclosure Statements

In a January 4, 2005 teleconference with Examiner Murphy, we discussed the fact that Applicants have not received an initialed version of the PTO-1449 forms corresponding to the Information Disclosure Statements filed on May 25, 2001 and July 9, 2001. The Examiner assured Applicants that the references had been considered and made of record and that the initialed PTO-1449 forms will be sent with the next communication.

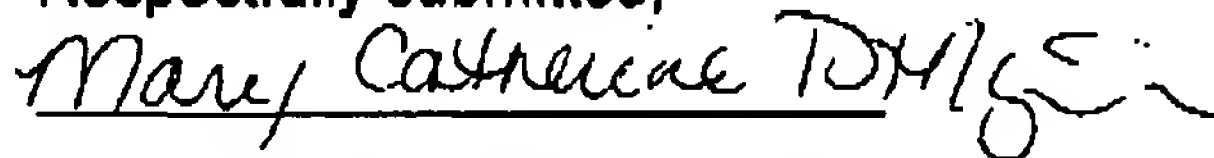
Summary

In view of the foregoing amendments and remarks, Applicants maintain that the claims pending in this application are in condition for allowance. Accordingly, allowance is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 50-3201.

Respectfully submitted,



Mary Catherine DiNunzio, Esq.
Registration No. 37,306
Synaptic Pharmaceutical Corporation
215 College Road
Paramus, New Jersey 07652
(201) 261-1331